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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/655,511	09/05/00	NOMI M	F-6636

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QM32/1017

EXAMINER  
JONES, S

ART UNIT	PAPER NUMBER
3713	9

DATE MAILED: 10/17/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

**Office Action Summary**

Application No.

09/655,511

Applicant(s)

NOMI ET AL.

Examiner

Scott E. Jones

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 August 2001.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) \_\_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 15 August 2001 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \*   c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5, 8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## **DETAILED ACTION**

### ***Response to Amendment***

1. This office action is in response to the amendment filed August 15, 2001 in which the applicant submits a substitute specification, a drawing correction, amends the claims, and responds to the claim rejections.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sagawa et al. in view of Kosugi et al. Sagawa et al. (E.P. 0,903,169,A2) discloses two operating sections with an operation input device comprising a keyboard input unit 13 and a turntable input unit 14 of figure 1, column 11, lines 34-36 (claim 1). Sagawa et al. discloses an effect producing device for producing a performance effect in response to a performance operation performed by the player to each of the operation members, column 1, lines 37-40 and column 2, lines 14-21 (claims 1 and 11). Sagawa et al. discloses a storage device for storing data of a musical composition and data of a performance procedure associated with the musical composition; a music play device for playing the musical composition based on the data stored in the storage device; and an operation instructing device for giving the player a visual instruction to operate the operation members in accordance with progress of a play of the musical composition based on the data stored in the storage device, column 1, lines 26-36, column 2, lines 22-32, and figures 7 and 10 (claims 1, 4

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and 5). Sagawa et al. discloses an estimation device may estimate the performance operation based on a difference between timing of the performance procedure and timing at which the player actually performed the performance operation, column 1, lines 41-45 and column 4, lines 7-11 (claims 1 and 10). Sagawa et al. discloses a sound effect producing device for producing the sound effects based on the operation input signals issued from the operation input device and the data of the sound effects stored in the storage device; and an estimation device for estimating operation of the player based on the operation input signals issued from the operation input device and the data of the performance procedure stored in the storage device, column 7, lines 16-24 (claim 1).

Sagawa et al. discloses producing at least one of the sound effects based on the operation input signals issued from the operation members and the data of the sound effects; estimating operations performed by the player based on the operation input signals issued from the operation members and the data defining the procedure, column 9, lines 4-10 (claim 2).

Sagawa et al. discloses an effect producing device may produce a reaction effect as one type of the performance effect each time the estimation device determines the estimation result, and the reaction effect may be changed in accordance with the estimation result, column 4, lines 16-20 (claim 3).

Sagawa et al. discloses a data storage device may store a plurality of data sets, each of which includes the data of the musical composition and the data of the performance procedure; and said game machine may further comprise a stage progress management device for controlling progress of a game in such a manner that when the estimation device gives a predetermined level of estimation with respect to the performance operation in one stage in

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which the musical playing device plays the musical composition based on one of the data sets; the game is allowed to progress to a next stage in which the music play device plays the musical composition and the instructing device instructs the performance operation based on another one of the data sets, column3, lines 29-42 (claims 6, 8 and 12).

Sagawa et al. discloses an indication of the indicator may change in such a manner that the length of each index mark represents a time period during which the player must hit a key repeatedly, column 16, lines 52-58 and column 17, line 1 (claim 7).

Sagawa et al. discloses a storage device for storing data of a musical composition and data of a performance procedure associated with the musical composition. This storage device may include a storage device such as a hard disk drive or a (replaceable) floppy disk, an optical or a magneto-optical storage device such as a (replaceable) CD-ROM, a semiconductor storage device such as a RAM or a ROM, or the various types of storage devices, column 1, lines 26-28 and column 9, lines 37-42 (claim 8). Sagawa et al. discloses a performance procedure presenting device for presenting the player with the performance procedure in a visual manner in association with a play of the musical composition based on the data of the performance procedure stored in the storage device, column 7, lines 10-15 (claim 8). Sagawa et al. discloses a sound effect producing device for producing the sound effects based on the operation input signals issued from the operation input device and the data of the sound effects stored in the storage device, column 7, lines 16-19 (claim 8).

Sagawa et al. discloses a storage device for storing data of a musical composition, data of a performance procedure with respect to each of the operation members of the operation input

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device, and data of sound effects corresponding to each of the operation members, column 7, lines 2-9 and figure 6, items 52, and 8a-c (claim 9).

Sagawa et al. discloses a player operates at least one of the operation members in association with the music, the performance effect corresponding to the operation is mixed on the music. Since the data of the performance procedure is stored in advance and correct timing to operate each operation member is indicated to the player through the operation instructing device in a visual manner, the player only has to operate the operation members in accordance with the instruction given from the game machine, column 1, lines 50-58, column 2, lines 1-3, and figures 3 and 4 (claim 11).

Sagawa et al. discloses two image display areas for displaying instructions to player(s) while moving the instructions with respect to a reference mark provided on the left and right sides of the screen and includes two signal generators provide on the left and right side of the game system, figure 1, items 5, 14, and 15a-e, and figure 9, items 65 a and b (claims 13 and 14).

Sagawa et al. does not explicitly disclose a signal-generating device held in the hand of a player which generates signals corresponding to hitting and swinging motions (claims 1 and 11). The patent to Kosugi et al. (U.S. Patent # 5,229,756) shows hand grip input devices used to signal an input (hitting or swinging) from a user to an image control apparatus to simulate a boxing match, abstract and figures 16-18 and figure 4, items a and b (claims 1 and 11).

It would have been obvious to one having ordinary skill in the art, at the time of the applicant's invention, to replace the turntable scratch pad and musical keyboard input keys of Sagawa et al. with the hand grip input device of Kosugi et al. making it easier for a game player to respond rapidly and accurately to an action shown on the display device.

*Response to Arguments*

4. Applicant's arguments filed August 15, 2001 have been fully considered but they are not persuasive.
5. Applicant submits corrections to the drawings and for reference designators referred to in the specification that were lacking. The drawing objections are withdrawn.
6. Applicant overcomes the objection to the title with the amendment.
7. Applicant overcomes objections to the specification by submitting a substitute specification.
8. Applicant overcomes the rejections to claims 1-14 under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter of the invention by submitting the claim amendments.
9. Applicant respectfully traverses the rejection to claims 1-14 under 35 U.S.C. § 103(a) as being unpatentable over Sagawa et al. in view of Kosugi et al. **as amended**.

Applicant alleges Kosugi cannot produce a signal unless a player bends his elbow or presses one of the input buttons on the left and right input devices. Applicant further notes, in contrast to Kosugi, by mounting a sensor for detecting at least one of an acceleration and an input, the device in accordance with the claimed embodiment, **when moved**, may sense a change in velocity, i.e., acceleration, or the device when hit against an object may sense an impact force generated by a point of contact.

Applicant admits that Kosugi generates a signal when a player bends an elbow. The examiner contends that when a player bends an elbow there must be a corresponding hand movement. Therefore, a movement is detected.

Applicant argues that claims 2-14 depend from claim 1 and therefore allegedly derive patentability at least in part therefrom as well as from the additional recitations they contain.

Regarding claims 2-14, applicant's arguments amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. General allegations of patentability are not persuasive arguments.

***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott E. Jones whose telephone number is (703) 308-7133. The examiner can normally be reached on Monday - Friday, 8:30 A.M. - 5:30 P.M..



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on (703) 308-1118. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3579 for regular communications and (703) 305-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1118.

Scott E. Jones  
Examiner  
Art Unit 3713

SEJ

sej

October 13, 2001

A handwritten signature in black ink, appearing to read "MICHAEL O'NEILL", written in a cursive, stylized script.

**MICHAEL O'NEILL**  
**PRIMARY EXAMINER**